

9200/1635



PATENT
ATTORNEY DOCKET NO.: DIVER1270-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Jay M. Short Art Unit: 1635
Application No.: 09/089,789✓ Examiner: S. McGarry
Filed: June 3, 1998
Title: CONSTRUCTION AND USE OF CATALOGUED NUCLEIC ACID
LIBRARIES THAT CONTAIN ADVANTAGEOUSLY ADJUSTED
REPRESENTATIONS OF DEFINED COMPONENTS

BOX DAC

Commissioner for Patents
Washington, D.C. 20231

TRANSMITTAL SHEET

Sir:

Transmitted herewith for the above-identified application, please find:

1. Petition for Withdrawal of the Holding of Abandonment
Under 37 C.F.R § 1.181(a); including Exhibit A (5 pages); and
3. Return Receipt Postcard.

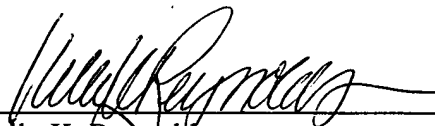
CERTIFICATION UNDER 37 CFR §1.8	
I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on this date, April 22, 2003, in an envelope addressed to: ATTN: BOX DAC, Commissioner for Patents, Washington, D.C. 20231.	
Cecilia Tobin Name of Person Mailing Paper	
Cecilia Tobin Signature	April 22, 2003 Date

Applicant: Jay M. Short
Application No.: 09/089,789
Filed: June 3, 1998
Page 2

No fee is deemed necessary in connection with the filing of this paper. However, if a fee is required, the Commissioner is hereby authorized to charge any additional required fees associated with the filing submitted herewith, or credit any overpayments to Deposit Account No. 50-1355. A duplicate copy of this sheet is attached.

Respectfully submitted,

Date: April 22, 2003



Kelly K. Reynolds
Registration No. 51,154
Telephone: (858) 638-6724
Facsimile: (858) 677-1465

USPTO CUSTOMER NUMBER 28213
GRAY CARY WARE & FREIDENRICH LLP
4365 Executive Drive, Suite 1100
San Diego, CA 92121-2133

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Applicant: Jay M. Short

Application No.: 09/089,789

Filed: June 3, 1998

Title: CONSTRUCTION AND USE OF CATALOGUED NUCLEIC ACID
LIBRARIES THAT CONTAIN ADVANTAGEOUSLY ADJUSTED
REPRESENTATIONS OF DEFINED COMPONENTS

Art Unit: 1635

Examiner: S. McGarry

#19

BOX DAC

Commissioner for Patents
Washington, D.C. 20231

**PETITION FOR WITHDRAWAL OF THE HOLDING OF ABANDONMENT
UNDER 37 C.F.R § 1.181(a)**

Sir:

Responsive to the Notice of Abandonment mailed February 3, 2003, Applicant hereby petitions for withdrawal of the holding of abandonment of the above-identified application under the provisions of 37 C.F.R. § 1.181(a) on the grounds that the Office Action was never received.

The above identified application became abandoned for Applicant's alleged failure to file a response to the Office Action mailed on May 9, 2002. It is respectfully submitted that Applicant did not file a response to the Office Action, as the Office Action was never received by Applicant. As Applicant was unable to submit a timely response, withdrawal of the holding of abandonment of the application is respectfully requested.

A search of the file jacket and docket records confirms that the May 9, 2002 Office Action for Application Serial No. 09/089,789 was not received by Applicant. As a showing of non-receipt of the Office Action, Applicant respectfully submits as "Exhibit A" a copy of the

CERTIFICATION UNDER 37 CFR §1.8	
I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on this date, April 22, 2003, in an envelope addressed to: ATTN: BOX DAC, Commissioner for Patents, Washington, D.C. 20231.	
Cecilia Tobin	
Name of Person Mailing Paper	
Cecilia Tobin	April 22, 2003
Signature	Date

docket report for Application Serial No. 09/089,789, listing all actions pending or taken in the application. It is noted that while the first Office Action, mailed February 12, 2001 and the response due dates thereto are noted on the list, no receipt of a second Office Action on May 9, 2002 is indicated. Had the Office Action been received, the 1 month response date (designated "2 mo rem") of June 9, 2002 and subsequent response dates through the 6 month response date of November 9, 2002 would be present on this docket report.

It is noted that the Notice of Abandonment was received on February 7, 2003, and that the delay in time from the receipt of that Notice to the filing of the present Petition was due to the exchange of phone calls between the Examiner and Applicant's representative and the Patent Office's ultimately unsuccessful attempt to locate a copy of the Office Action mailed May 9, 2002 and provide it to Applicant. It is noted that messages were left with the Examiner on February 18, 2003 and April 3, 2003. The Examiner called Applicant's representative regarding this action on February 24, 2003, April 7, 2003 and April 9, 2003. The delay between the phone calls was when the Patent and Trademark Office was attempting to locate a copy of the Office Action allegedly mailed May 9, 2003. The Examiner and Applicant's representative further discussed this matter on April 21, 2003, at which time Applicant's representative was requested to submit the present petition, as the Patent Office remains unable to locate a copy of the May 9, 2002 Office Action. After the interview, this Petition was immediately drafted. Therefore, under the exception of 37 C.F.R. §1.183, Applicant respectfully requests consideration of this petition, even though it is submitted more than 2 months after the date of mailing of the Notice of Abandonment, as the delay was primarily due to the Patent Office's inability to locate a copy of the Office Action mailed May 9, 2002.

In re Application of: Jay M. Short
Application No.: 09/089,789
Filed: June 3, 1998
Page 3

PATENT
Attorney Docket No. DIVER1270-3

Applicant therefore respectfully requests a withdrawal of the holding of abandonment on the grounds that the Office Action mailed May 9, 2002 was never received by the Applicant and that the PTO is now unable to locate the Office Action mailed May 9, 2002. No fee is believed due with the present response. However, please charge any additional fees, or make any credits, to Deposit Account No. 50-1355. If the Examiner would like to discuss any of the issues raised herein, Applicant's representative can be reached at (858) 638-6724.

Respectfully submitted,

Date: April 22, 2003



Kelly K. Reynolds
Registration No. 51,154
Telephone: (858) 638-6724
Facsimile: (858) 677-1465

USPTO CUSTOMER NUMBER 28213
GRAY CARY WARE & FREIDENRICH LLP
4365 Executive Drive, Suite 1100
San Diego, California 92121-2133

Enclosure: Exhibit A

Country Application

21-Apr-03

Docket Number: DIVER1270

SubCase: 3

• **Country:** US United States of America

Client: Diversa Corporation

Client Ref.:

Case Type: CIP **Application Status:** Abandoned **Entity:** SE **Area(s):**

Application Number: 09/089,789

Filing Date: 03-Jun-1998

WO

Patent Number:

Issue Date:

Publication Number:

Publication Date:

Priority Number: 09/034,724

Priority Date: 04-Mar-1998

Examiner/Agent:

Expiration Date:

Examiner/Agent Ref. #:

Paralegal:

Matter Number: 159195

Tax Start Date:

Legacy Docket #:

Ann. Serv. Status:

List Of Actions

Action(s) Du	Due Date		Action Taken
Informal Missing Parts	03-Aug-1998	Due Date	03-Aug-2000
Information Disclosure Strmnt	03-Sep-1998	Due Date	14-Oct-1999
IDS 6 Months Late	03-Mar-1999	Due Date	
Foreign Filing Reminder	03-Apr-1999	Due Date	03-Jun-1999
Foreign Filing Due	03-Jun-1999	Final	03-Jun-1999
IDS 9 Months Late	03-Jun-1999	Final	
1 Month Response Due	30-Jul-1999	Due Date	30-Sep-1999
1 Month Resp. w/1st Ext.	30-Aug-1999	Due Date	30-Sep-1999
1 Month Resp. w/2nd Ext.	30-Sep-1999	Due Date	30-Sep-1999
Status of Postcard	14-Oct-1999	Due Date	14-Oct-1999
1 Month Resp. w/3rd Ext.	30-Oct-1999	Due Date	30-Sep-1999
1 Month Resp. w/4th Ext.	30-Nov-1999	Due Date	30-Sep-1999
Application Status Check	03-Dec-1999	Due Date	03-Dec-1999
Foreign Filing Follow Up Date	03-Dec-1999	Due Date	03-Jun-1999
1 Month Resp. w/5th Ext.	30-Dec-1999	Final	30-Sep-1999
IDS from ISR(19) for US Due	08-Mar-2000	Due Date	04-May-2000

Country Application

21-Apr-03

Status Check	30-Mar-2000	Due Date	30-Mar-2000
IDS from ISR(19) 2 Mos Late	08-Apr-2000	Due Date	04-May-2000
IDS from ISR(19) 3 Mos Late	08-May-2000	Due Date	04-May-2000
IDS from ESR for US Due	06-Jul-2000	Due Date	24-Aug-2000
IDS from ESR 2 mos late	06-Aug-2000	Due Date	24-Aug-2000
IDS from ESR 3 mos late	06-Sep-2000	Due Date	24-Aug-2000
Restriction Due Date-Election	03-Nov-2000	Due Date	03-Nov-2000
IDS from ISR(19 Follow Up Date	04-Nov-2000	Due Date	04-Nov-2000
Rest'n: 1st Extension	03-Dec-2000	Reminder	03-Nov-2000
Rest'n: 2nd Extension	03-Jan-2001	Reminder	03-Nov-2000
Rest'n: 3rd Extension	03-Feb-2001	Reminder	03-Nov-2000
IDS from ESR fo Follow Up Date	24-Feb-2001	Due Date	24-Aug-2000
Rest'n: 4th Extension	03-Mar-2001	Reminder	03-Nov-2000
3 Mon OA 2 mo rem	12-Mar-2001	Reminder	13-Aug-2001
Rest'n: 5th Extension	03-Apr-2001	Final	03-Nov-2000
3 Mon OA 1 mo rem	12-Apr-2001	Reminder	13-Aug-2001
US-Restriction- Follow Up Date	03-May-2001	Due Date	15-Aug-2001
3 Mon OA: Due Date	12-May-2001	Due Date	13-Aug-2001
3 Mon OA: 1st Extension	12-Jun-2001	Reminder	13-Aug-2001
3 Mon OA: 2nd Extension	12-Jul-2001	Reminder	13-Aug-2001
3 Mon OA: 6 Month Final	12-Aug-2001	Final	13-Aug-2001
US-3 Month Offi Follow Up Date	13-Feb-2002	Due Date	13-Aug-2001
Supp Response Filed	04-Sep-2002	Due Date	04-Sep-2002
Supp Response F Follow Up Date	04-Mar-2003	Due Date	17-Sep-2002

Status Comments: This application is a continuation-in-part of U.S. Patent Application Serial Number 09/034,724, filed March 4, 1998, now U.S. Patent Number 6,001,574; which is a continuation-in-part of U.S. Patent Application Serial Number 08/665,565, filed June 18, 1996, now U.S. Patent Number 5,763,239.

Remarks: 02/07/2003 Recv'd Notice of Abandonment

User ID: tdelangen

Date Created: 19-Jan-2000

Last Update: 07-Feb-2003

Country Application

10-Sep-03

IDS from ISR(19) for US Due	08-Mar-2000	Due Date	04-May-2000
Status Check	30-Mar-2000	Due Date	30-Mar-2000
IDS from ISR(19) 2 Mos Late	08-Apr-2000	Due Date	04-May-2000
IDS from ISR(19) 3 Mos Late	08-May-2000	Due Date	04-May-2000
IDS from ESR for US Due	06-Jul-2000	Due Date	24-Aug-2000
IDS from ESR 2 mos late	06-Aug-2000	Due Date	24-Aug-2000
IDS from ESR 3 mos late	06-Sep-2000	Due Date	24-Aug-2000
Restriction Due Date-Election	03-Nov-2000	Due Date	03-Nov-2000
IDS from ISR(19 Follow Up Date	04-Nov-2000	Due Date	04-Nov-2000
Rest'n: 1st Extension	03-Dec-2000	Reminder	03-Nov-2000
Rest'n: 2nd Extension	03-Jan-2001	Reminder	03-Nov-2000
Rest'n: 3rd Extension	03-Feb-2001	Reminder	03-Nov-2000
IDS from ESR fo Follow Up Date	24-Feb-2001	Due Date	24-Aug-2000
Rest'n: 4th Extension	03-Mar-2001	Reminder	03-Nov-2000
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Rest'n: 5th Extension	03-Apr-2001	Final	03-Nov-2000
3 Mon OA 1 mo rem	12-Apr-2001	Reminder	13-Aug-2001
US-Restriction- Follow Up Date	03-May-2001	Due Date	15-Aug-2001
3 Mon OA: Due Date	12-May-2001	Due Date	13-Aug-2001
3 Mon OA: 1st Extension	12-Jun-2001	Reminder	13-Aug-2001
3 Mon OA: 2nd Extension	12-Jul-2001	Reminder	13-Aug-2001
3 Mon OA: 6 Month Final	12-Aug-2001	Final	13-Aug-2001
US-3 Month Offi Follow Up Date	13-Feb-2002	Due Date	13-Aug-2001
Supp Response Filed	04-Sep-2002	Due Date	04-Sep-2002
Supp Response F Follow Up Date	04-Mar-2003	Due Date	17-Sep-2002
Statement re Interview Summary	24-May-2003	Due Date	

Status Comments: This application is a continuation-in-part of U.S. Patent Application Serial Number 09/034,724, filed March 4, 1998, now U.S. Patent Number 6,001,574; which is a continuation-in-part of U.S. Patent Application Serial Number 08/665,565, filed June 18, 1996, now U.S. Patent Number 5,763,239.

Remarks: 02/07/2003 Recv'd Notice of Abandonment
04/22/2003 Petition for Withdrawal of the Holding of
Abandonment filed w/USPTO. Rec'd posted for same on 05/07/03
8/8/2003 Recv'd Decision on Petition filed 4/22/03. Petition
Dismissed.

Country Application

10-Sep-03

Docket Number: DIVER1270

SubCase: 3

Country: US United States of America

Client: Diversa Corporation

Client Ref.:

Case Type: CIP **Application Status:** Abandoned **Entity:** SE **Area(s):**

Application Number: 09/089,789

Filing Date: 03-Jun-1998

WO

Patent Number:

Issue Date:

Publication Number:

Publication Date:

Priority Number: 08/665,565

Priority Date: 18-Jun-1996

Examiner/Agent:

Expiration Date:

Examiner/Agent Ref. #:

Paralegal:

Matter Number: 159195

Tax Start Date:

Legacy Docket #:

Ann. Serv. Status:

List Of Actions

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Foreign Filing Due	03-Jun-1999	Final	03-Jun-1999
IDS 9 Months Late	03-Jun-1999	Final	
Request for Examination	18-Jun-1999	Due Date	
1 Month Response Due	30-Jul-1999	Due Date	30-Sep-1999
1 Month Resp. w/1st Ext.	30-Aug-1999	Due Date	30-Sep-1999
1 Month Resp. w/2nd Ext.	30-Sep-1999	Due Date	30-Sep-1999
Status of Postcard	14-Oct-1999	Due Date	14-Oct-1999
1 Month Resp. w/3rd Ext.	30-Oct-1999	Due Date	30-Sep-1999
1 Month Resp. w/4th Ext.	30-Nov-1999	Due Date	30-Sep-1999
Application Status Check	03-Dec-1999	Due Date	03-Dec-1999
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1 Month Resp. w/5th Ext.	30-Dec-1999	Final	30-Sep-1999



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/089,789	06/03/1998	JAY M. SHORT		3204

7590 02/03/2003

LISA A. HAILE, PH.D.
GRAY CARY WARE AND FREIDENRICH, LLP
4365 EXECUTIVE DRIVE, SUITE 1600
SAN DIEGO, CA 92121

EXAMINER

MCGARRY, SEAN

ART UNIT PAPER NUMBER

1635

DATE MAILED: 02/03/2003

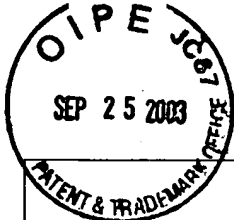
17



PATENT DOCKETING

FEB 07 2003

Please find below and/or attached an Office communication concerning this application or proceeding.



Notice of Abandonment

Application No.

09/089,789

Examiner

Sean R McGarry

Applicant(s)

SHORT, JAY M.

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--


This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 5/9/02.
 - (a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.
 - (b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.
(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
 - (c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
 - (d) ☒ No reply has been received.
2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
 - (a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
 - (b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.
The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.
 - (c) ☐ The issue fee and publication fee, if applicable, has not been received.
3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
 - (a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.
 - (b) ☐ No corrected drawings have been received.
4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.
7. ☐ The reason(s) below:

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OFFICE OF PETITIONS


SEAN MCGARRY
PRIMARY EXAMINER
1635

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/089,789	06/03/1998	JAY M. SHORT		3204

7590

04/24/2003

LISA A. HAILE, PH.D.
GRAY CARY WARE AND FREIDENRICH, LLP
4365 EXECUTIVE DRIVE, SUITE 1600
SAN DIEGO, CA 92121



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APR 29 2003

EXAMINER

MCGARRY, SEAN

ART UNIT PAPER NUMBER

1635

DATE MAILED: 04/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

PATENT DOCKETING

APR 29 2003

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OFFICE OF PETITIONS



Interview Summary

Application No.	Applicant(s)	
09/089,789	SHORT, JAY M.	
Examiner	Art Unit	
Sean R McGarry	1635	

All participants (applicant, applicant's representative, PTO personnel):

(1) Sean R McGarry. (3) _____

(2) Kelly Reynolds for Lisa Haile. (4) _____

Date of Interview: 22 April 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.

If Yes, brief description: _____.

Claim(s) discussed: N/A.

Identification of prior art discussed: N/A.

Agreement with respect to the claims: f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant representative called in reference to the notice of abandonment mailed 2/3/03. Applicants representative indicated that the Official Action mailed 5/9/02 was not received and requested a copy of the Official Action in order to properly respond with petition to revive. the examiner indicated that no copy of the Official Action was located in the file. It was suggested to applicants representative to also file a Petition to Withdraw the Holding of Abandonment.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

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OFFICE OF PETITIONS

SEAN MCGARRY
PRIMARY EXAMINER

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.